



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,989	09/25/2003	Michael Wisniewski	PROS1130	4517
44654 7590 05/19/2009 SPRINKLE IP LAW GROUP 1301 W. 25TH STREET SUITE 408 AUSTIN, TX 78705				
EXAMINER				
FEENEY, BRETT A				
ART UNIT		PAPER NUMBER		
3624				
MAIL DATE		DELIVERY MODE		
05/19/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/670,989

Applicant(s)

WISNIEWSKI ET AL.

Examiner

BRETT FEENEY

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 7, 12, 23, 24 and 34-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 12, 23, 24 and 34-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. The following **NON-FINAL** Office Action is in response to Applicant's submission received April 15, 2009.
2. Claims 1 – 3, 6 – 7, 12, 23 and 24 were amended. Claims 4 – 5, 8 – 11, 13 – 16, 18 – 22 and 25 – 33 were canceled. Claims 34 – 42 were added.
3. Claims 1 – 3, 6 – 7, 12, 23, 24 and 34 – 42 are pending and have been examined.

Continued Examination under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/15/2009 has been entered.

Response to Amendment

5. The rejection under 35 USC § 101 is withdrawn as a result of Applicant's amendments to the claims. The Examiner has entered a new rejection under 35 USC § 112 and 35 USC § 103 as a result of Applicant's amendments to the claims.

Response to Arguments

6. Applicant's arguments received on April 15, 2009 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above. This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
7. Applicants' arguments filed have been fully considered but are not found persuasive. Applicants argues
 - i) Choi does not disclose analyzing a distribution of responses.
 - ii) Choi does not disclose the method steps recited in independent claim 1.

In response to applicant's argument that Choi does not disclose analyzing a distribution of responses, the Examiner respectfully disagrees. Choi explicitly discloses analyzing a distribution of responses *inter alia* "...distributions of about 25% agree/important, 50% neutral/no opinion, 25% disagree/unimportant." (column 5, lines 8-16). Further, the Examiner notes that while the portions of Choi cited by Applicant are directed to characterizing customers, Choi also discloses methods for evaluating "price-

attribute-bundle", brand positioning, purchasing behavior, marketing channel effectiveness and the like.

In response to applicant's argument that Choi does not disclose the method steps of independent claim 1, the Examiner respectfully disagrees, except for the method step of *"repeating the selecting, presenting, receiving and storing steps for each customer of a plurality of customers"*, which is disclosed by Holloway (see rejection of **Claim 1** for further detail).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 – 3, 6 – 7, 12, 23, 24 and 34 – 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- Claims 1, 12, and 23 recite *"selecting, by action selection algorithm module on the action selection algorithm computer, an action from a set of actions associated with the profile using an action selection algorithm"*. The claim is indefinite on its face because essential steps are missing. It is unclear how the algorithm module selects an action from the set of actions. For example does it apply a model to select the action based on some statistical probabilities, does it use a vectoring algorithm, does it perform a cluster analysis or the like; or alternatively, does it apply a set of rules based on the customer profile and

customer information. Further, if it uses an algorithm, it is not clear what specific algorithm is used. The dependent claims are also considered vague and indefinite as they depend from the aforementioned independent claims.

- Claims 1 – 3, 6 – 7, 12, 23, 24 and 34 – 42 recite "an action". The specification defines an action to mean "a unique treatment or stimulus from a set of alternatives applicable to a specific context". An "action" is ordinarily used in the art as a verb to describe a step or series of steps performed. However as recited in the claim(s), and used in the specification, an action may be a noun such as a price list, script, contract or the like. This appears to be in direct conflict with the special definition provided in the specification "treatment or stimulus" (which implies an active step i.e. verb) and the ordinary meaning used in the art. Therefore the claim(s) are indefinite on their face.

Rejections under § U.S.C. 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

12. **Claims 1-4, 6-9, 12-17, 19, 20, 23, 24, 28, 29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi et al. (US 6,895,405), in view of Holloway et al., (US 2003/0033193 A1).**

Claim 1

Choi shows:

- *providing a system* (see at least FIG 9 and associated text in column 29, lines 9-53; Noting Choi teaches a computer that contains a storage medium, processor, database, instructions, interfaces and the like.)
- *receiving information about a customer* (see at least FIG 11 and associated text in column 2, lines 47-67; Noting, customer information is received via a survey. Further, noting the information from the surveys may be received from another

party (i.e. double blinded studies conducted) or "indicat[ed] that a survey variable was important" (i.e. directly from the customer).);

- While Choi explicitly teaches: *[wherein the information comprises one or more of clickstream data, information directly entered by the customer, and information acquired by an agent]*; the Examiner notes that describing the type of data (i.e. customer information data), does not further limit the claim as the limitation is drawn to non-functional descriptive material and is not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ' 2106.
- *matching the information about the customer to a profile stored in the customer profile database based on the customer information and one or more of a customer need and a business context (Id. Noting, that the process of segmentation is matching customer responses with others that respond[ed] the same. Each cluster is a profile for a group of respondents (customers).);*
- *selecting an action from a set of actions associated with the profile using an action selection algorithm, wherein each action in the set of actions is a unique stimulus, wherein the set of actions comprises a plurality of alternative actions for*

a specific context (see at least column 4, lines 63-67; Noting that price-of-entry variables are removed from the survey, such that the list of available survey questions is reduced when they are not predictive for that segment profile).

- *presenting the action to the customer of the plurality of customers associated with the profile (Id.);*
- *receiving a response to the action from the customer* (see at least column 4, lines 56-67; Noting that responses to survey questions are gathered to determine which questions best identify a given segment.);
- *storing the response in the database* (see at least FIG 9 and associated text in column 29, lines 9-53; Noting, Choi teaches saving responses based on every methodology disclosed in databases.);
- *determining a distribution of customer responses to the set of actions* (see at least column 5, lines 8-16; Noting "...distributions of about 25% agree/important, 50% neutral/no opinion, 25% disagree/unimportant.");
- *analyzing the distribution of responses to all actions of the set of actions presented to the customers associated with the profile, wherein the analysis identifies one action of the set of actions having a desired outcome* (see at least FIG 11 and associated text; Noting, Rosetta segmentation determines homo and hetero-scedaticity of responses indicating discriminating and predictive responses.);
- *updating the database based on the analysis of the distribution of responses, wherein future actions presented to customers associated with the profile are*

selected from the updated database (see at least column 19, lines 10-41; Noting, that product, advertising, promotional strategies, marketing channels and the like may be determined based on the responses.).

Choi teaches clustering similar respondents for the purpose of targeted marketing. Choi does not explicitly teach a method for interactive marketing *per se*, however Holloway shows:

- *repeating the selecting, presenting, receiving and storing steps for each customer of a plurality of customers* (see at least paragraph 0010; "...the programming instructions include instructions for causing the client to parse the data elements from the survey document into data arrays. The data arrays include cross-references defining associations among questions and answers. The arrays provide an efficient data structure by which the applet can follow a chain of cross references and compile, for adding to the survey, branches of sub-questions for particular answers received from a user.");

It would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the system and method for collecting and analyzing customer information taught Choi with the system and method of interactive marketing taught by Holloway because interactive surveys allows businesses to better understand their customers and present relevant product information, sales offers and the like thereby increasing revenues through targeted marketing.

Claim 2

Choi/Holloway teaches the limitations above. Furthermore, Choi shows:

- *wherein matching the information about the customer to a profile further comprises collecting historical information* (see at least column 5, lines 35-60; Noting the various data collected on customers pertaining to their responses. Further, see at least column 31, lines 8-19; Noting, "historical data").

Claim 3

Choi/Holloway teaches the limitations above. Furthermore, Choi shows:

- *receiving information about a customer further comprises augmenting the information with information received from external sources* (see at least column 3, lines 1-16, noting survey questions are asked of individuals, who are external sources to the marketing firm. Further, see at least FIG 3 and associated text in column 23, lines 25-37; Noting initial data is appended based on observational information.).

Claim 6

Choi/Holloway teaches the limitations above. Furthermore, Choi shows:

- *wherein the set of actions is specific to the profile, wherein each action in the set of actions is selected based on a response forecast, and wherein a response to the action presented to the customer is used to update the set of action contained in the response forecast* (Choi discloses the set of actions is specific to the profile, see at least column 4, lines 56-67; Noting that the questions are

asked because of their link to a particular segment/profile/cluster, and therefore are specific to that profile and how respondents respond to the question(s).).

Claim 7

Choi/Holloway teaches the limitations above. Furthermore, Choi shows:

- *wherein the action database contains a history of responses for each action, wherein the action selection algorithm analyzes the history of responses associated with the profile in selecting an action from the set of actions* (Choi discloses a history of responses for the profile in selecting an action from the set of actions, see at least column 5, lines 17-22; noting the responses are a history of the customer's responses that are used to determine the effectiveness of a question, which is used to determine if it is asked to future customers).

Claims 12-15, 17, 23, 24, 28 and 29 recite limitations addressed in the claims above and are therefore rejected for similar reasons.

Claim 34

Choi/Holloway teaches the limitations above. Furthermore, Choi shows:

- *wherein the distribution of responses is analyzed* (*Id.* at **Claim 1**. Further, see at least column 19, lines 43-49; Noting Choi explicitly teaches practicing the disclosed method to maximize profit.).

- The Examiner notes [*to determine an action having the set of offers in a selected order to maximize profit*] is directed to non-functional descriptive material.

Claim 35

Choi/Holloway teaches the limitations above. Furthermore, Choi shows:

- *The method of claim 1,*
- *wherein the distribution of responses is analyzed (Id. at Claim 1. Further, see at least column 19, lines 1-9; Noting Choi explicitly practicing the disclosed method to maximize revenue.).*
- The Examiner notes [*to determine an action having the set of offers in a selected order to maximize revenue*] is directed to non-functional descriptive material.

Claim 36

Choi/Holloway teaches the limitations above. Furthermore, Choi shows:

- The Examiner notes that the limitation disclosed in the claim is directed to non-functional descriptive material. However, Choi explicitly teaches presenting “price-attribute-bundle[s]” to customers to determine the customer’s need and willingness to pay for product features. Further, Choi performs this method in context of the method described in the claims above in order to maximize profit and revenue (*Id. at Claim 1, Claim 34 and Claim 35*).

Claim 37

Choi/Holloway teaches the limitations above. Furthermore, Choi shows:

- *wherein the action presented to a customer is selected from the set of actions based on the price, wherein the price is below the customer's willingness to pay* (Id. Further, see at least column 8, lines 1-14; Noting, Choi teaches econometric customer profiling based on a plurality of data including product price and customer's willingness to pay (i.e. purchase) a product given a set of alternatives.).

Claims 38 - 43 recite limitations addressed in the claims above and are therefore rejected for similar reasons.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRETT FEENEY whose telephone number is (571)270-5484. The examiner can normally be reached on M - R 7:30 - 6:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brad Bayat can be reached on 571.272.6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

7 May 2009
/Brett Feeney/
AU 3624

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624